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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/050,460	01/15/2002	Olaf Vancura	2001/7	6092

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DORR CARSON SLOAN & BIRNEY, PC
3010 EAST 6TH AVENUE
DENVER, CO 80206

EXAMINER	
ONEILL, MICHAEL W	

ART UNIT	PAPER NUMBER
3713	

DATE MAILED: 06/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/050,460	VANCURA, OLAF	
	Examiner	Art Unit	
	Michael O'Neill	3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 April 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *21-39* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *21-39* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *4-5-5*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

The amendment filed 4-5-2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: new claims 21-39 contain a new limitations of "a single spin outcome" and "the single spin outcome", the originally filed specification makes no mention of such limitations.

Applicant is required to cancel the new matter in the reply to this Office Action.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed method steps within claims 21-39 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior

version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 21-39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The originally filed specification makes no mention of the new claim limitations of "a single spin outcome" or "the single spin outcome". Thus, these limitations have no basis within the originally filed specification and thus deemed new matter being presented in an amendment to the specification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 21, 23, 27, 28, 34-36, 38 and 39 are rejected under 35 U.S.C. 102(e) as being anticipated by Bennett et al. USPN 6,648,758.

Bennett et al. discloses a gaming machine with player selected bonus games. As shown in the front page figure, Bennett et al. gaming machine generates and displays a matrix of symbols during a single spin when the proper amount of credits are inserted therein. As described in column 4, Bennett et al. discloses a trigger feature: specific symbols shown on the first and last reels or columns of the matrix. Also in column 4, Bennett et al. discloses the player selectable wild feature in three separate steps or means: one is the player may select a favorite symbol as the bonus symbol; a second is particular reels or columns the constitute the matrix may provide special symbols, which substitute for other symbols and act as wild symbols (also disclosed the player can be allowed to select amounts (factors) by which wins will be multiplied when the special symbol substitutes in a win on reels; and a third way is allowing the player to choose the symbols that will act as the substitute and/or scatter symbols during the feature game series. As an exemplary embodiment, viewing figures 3 and 4, FIG. 3 shows a display screen of a first game having three paylines 1, 2, 3. Prizes are paid for combinations of three or more of the same symbol appearing left to right or right to left on a payline. The wild symbol 100 substitutes for all symbols and only appears on reels 2 (102) and 4 (104). If two wild

symbols 100 appear on the display screen 14 at the same time, the feature game series is triggered. FIG. 3 shows the appearance of two wild symbols 100 triggering the feature game series. The display 14 then changes to a player choice screen illustrated in FIG. 4. The choices offered to the player are the choice of the multipliers applicable to substitute wins such as described in the general description of the game set out above (The options are slightly different in FIG. 4). If the player presses button 4, then for the duration of the ten free games, the wild symbols on reel 2 and 4 display ".times.10" and ".times.2" respectively. Any wins in which the reel 2 wild symbol 100 substitutes, will pay ten times the usual prize for the combination. Similarly, wins in which the reel 4 wild symbol substitutes will pay twice the usual prize. Of course, any win with both wild symbols substituting, will play twenty times the usual prize. Re. claim 23, see FIG. 5.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the

> art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett et al. '758.

What Bennett et al. discloses to those skilled in the art is discussed above and incorporated herein. What the reference lacks in clearly disclosing is randomly choosing said enhanced multiplier. Instead, what is disclosed are a plurality of enhanced multipliers to which the product of two multipliers chosen equals 20x, e.g. if 2x and 10x are chosen, then the multiplier used for the bonus is 20x. However, those skilled in the art understand the need to add interest in the gaming machines developed. Interest in games is developed by excitement through providing the unexpected; yet a same time maintain the proper volatility for the hold percentages. One way to do this would be to randomize the enhanced multipliers to yield the 20x multiplier for the bonus. Doing such would not destroy the reference because the reference lists a series of enhanced multipliers and all that is required by the reference is to maintained the 20 multiplier for the bonus. Therefore, one skilled in the art would find it obvious to randomize the enhancing multipliers disclosed in Bennett et al. and be

motivated to do so in order to maintain interest in the game which is well understood to those of ordinary skill in the art.

Claims 22, 25, 26, and 29-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett et al. '758 in view of O'Halloran, USPN 6,439,993.

What Bennett et al. discloses has been discussed above and incorporated herein. What the reference clearly lacks in disclosing is converting all or a portion of the other symbols adjacent to the wild symbol into wild symbols. In an analogous gaming machine, as shown clearly in the figures, O'Halloran provides such a teaching. One of ordinary skill in the art would find it obvious to apply such a teaching to Bennett et al. and would be motivated to do so in order to provide addition interest in the gaming machine disclosed in Bennett et al.

Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett et al. '758 in view of Stupak 5,695,402.

What Bennett et al. discloses has been discussed above and incorporated herein. What the reference clearly lacks in disclosing is triggering via successive losses. Stupak teaches in an analogous gaming machine that it is well know to trigger prizes with a plurality of successive losses in order to maintain a player's interest in that particular gaming machine.

Therefore, it would have been obvious to one of ordinary skill in the art to apply the teachings in Stupak to the invention disclosed in Bennett et al. for the motivations found in Stupak.

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection and the new claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael O'Neill whose telephone number is 571-272-4442. The examiner can normally be reached on Tuesday through Friday 8:00 am to 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan M. Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael O'Neill
Primary Examiner